

## REMARKS

Claims 24-46 remain in this application. Claims 12-31 are rejected. Claims 32-46 are withdrawn from consideration. Claim 24 is amended herein to clarify the invention.

Applicants herein traverse and respectfully request reconsideration of the rejection of the claims cited in the above-referenced Office Action.

Claims 24-31 are rejected as obvious over Hashimoto (US 5,484,685) under 35 U.S.C. §103(a). The applicants herein respectfully traverse this rejection. For a rejection under 35 U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

It is respectfully submitted that a *prima facie* case of obviousness could not be properly established in the rejection of claims 24-31 as written. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of

success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP §706.02(j) "Contents of a 35 U.S.C. §103 Rejection".

Claim 24 is amended to clarify that the claimed solidified wood melts recited are created "by exposure of at least a portion of the article of wood to an increased temperature which raises the wood comprising said at least a portion of the article of wood above a melting point thereof." This clearly distinguishes claim 24, and the remaining pending claims dependent therefrom, from the disclosure of Hashimoto, in accordance with which, lignin in the cell structure of wood is dissolved by a solvent, rather than involving a true melting of a portion of the wood by application of heat above a melting point. Applicants respectfully submit that the resulting structures produced according to the present invention and Hashimoto, respectively, necessarily exhibit differing characteristics owing to the drastically different manner of treatments. In this regard, it is noted that heating a substance above a melting point thereof, and allowing the substance to re-solidify by a reduction in temperature below the melting point, results in a dramatically different physical structure than that resulting, instead, by dissolving the same substance in a solvent and effecting evaporation of the solvent by heating kept below a melting point of the wood. Therefore, since the resulting products, made in accordance with the present claims and Hashimoto, have a different structural nature, applicants submit that the product-by-process claims of claims 24-31 adequately distinguish over the cited reference.

Based upon the foregoing, it is respectfully submitted that the Hashimoto reference fails to teach or suggest all the claim limitations as properly required to establish a *prima facie* case of obviousness. Therefore, reconsideration of the rejection of claims 24-31 and their allowance are respectfully requested.

Applicants respectfully request a three (3) month extension of time for responding to the Office Action. Please charge the fee of \$950 for the extension of time to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,  
Jordan and Hamburg LLP

By C. Bruce Hamburg  
C. Bruce Hamburg  
Reg. No. 22,389  
Attorney for Applicants

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340

James J. Thiele  
Reg No 36,049